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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,565	11/05/2003	Alfred E. Mann	AB-357P; MB-103; 203/526	8737
27224	7590	06/03/2005	EXAMINER	
ARTHUR FREILICH 9045 CORBIN AVE, #260 NORTHRIDGE, CA 91324-3343			DABNEY, PHYLESHA LARVINIA	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/702,565

Applicant(s)

MANN ET AL.

Examiner

Phylesha L. Dabney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/3/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This action is in response to the application filed on 05 November 2003 in which claims 1-22 are pending.

#### *Claim Objections*

1. Claims 1-19 are objected to because of the following informalities: the claims are reciting a hearing aid positioned in the ear and an external/remote device being used for producing audio in the ear, which suggests that the claims are pertaining to a hearing aid "system" not just a hearing aid. Appropriate correction is required.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,897,695. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

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limitations of the claims in the present application are covered by the scope of the claims in the patent with obvious wording variations.

Regarding the claims, Malten '695 teaches a hearing aid, comprising: an implant comprising: a case, implanted electronic circuitry; a transducer; an antenna; and a power source; a microphone module; and at least one telemetry link. Malten '695 does not teach the specific details of the microphone module as comprising: a housing, external electronics within the housing, at least one microphone, at least one external antenna, and a power source electrically connected to the electronics. However, including these features with a microphone module is well known in the art for transmitting/receiving information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to beneficially program and control the implanted hearing aid.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

3. Claims 1-22 are rejected under 35 U.S.C. 102(e, f) as being anticipated by Malten et al (U.S. Patent No. 6,879,695).

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The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1, 8-9, 11 and 17-18, Malten et al teaches a hearing aid, comprising: an implant configured for insertion into a recess under the skin of a retro-auricular space, which implant does not occlude an ear canal, the implant comprising: a case (61), implanted electronic circuitry (66, 67; col. 6 lines 17-48) housed in the case; a transducer (63, 65) electrically connected to the electronic circuitry; an antenna (64) electrically connected to the electronic circuitry; and a power source (66) electrically connected to the electronic circuitry; a microphone module (75-77; col. 4 line 49 through col. 8 line 49) configured for external use, comprising: a housing, external electronics within the housing, at least one microphone electrically connected to the electronics, at least one external antenna electrically connected to the electronics, and a power source electrically connected to the electronics; and at least one telemetry link (69) between the at least one external antenna and the implant antenna, allowing transmission between the microphone module and the implant; wherein audio information received by the at least one microphone is processed by the external electronics, transmitted by the at least one telemetry link to the implant, and emitted by the transducer into the ear canal.

Regarding claim 2, Malten teaches the transducer (65) is located at a distal end of the case, which distal end is positioned under the skin of the ear canal.

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Regarding claim 3, Malten teaches the transducer is located at a distal end of the case, which distal end protrudes slightly into the ear canal (col. 5 lines 40-46; col. 5 line 66 through col. 6 line 6).

Regarding claim 4, Malten teaches the implanted power source comprises a rechargeable battery (col. 9 lines 51-65).

Regarding claim 5, Malten teaches the implanted power source comprises a super capacitor (col. 9 lines 51-65).

Regarding claim 6, Malten teaches the implant case comprises one piece (col. 5 lines 46-59).

Regarding claim 7, Malten teaches the implant case comprises more than one piece (col. 5 lines 46-59).

Regarding claim 10, Malten teaches a coating on at least part of the implant case, which coating comprises at least one material for at least one of promoting healing, resisting infection, resisting inflammation, and facilitating integration of the implant with body tissue (col. 8 lines 56-63).

Regarding claim 12, Malten teaches the signal processing circuitry that performs voice command recognition (col. 6 lines 27-48).

Regarding claim 13, Malten teaches means for communicating with a commercial electronics device (col. 6 lines 26-27; col. 6 line 49 through col. 7 line 2).

Regarding claim 14, Malten teaches the means for communicating includes a telemetry communication technique (col. 6 lines 49-57).

Regarding claim 15, Malten teaches the means for communicating includes a direct

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electrical connection (72).

Regarding claim 16, Malten teaches at least one external programming unit for customizing the hearing aid for a user; and means for communicating with the at least one external programming unit (col. 7 lines 29-42).

Regarding claims 19-22, see the rejection of claims 1-18 above.

4. Claims 1-22 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Although the same materials seems to be disclosed, the list of inventors listed for this instant application is different from the inventors listed for Patent No. 6,879,695.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phylesha L. Dabney whose telephone number is 571-272-7494. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, Fridays 8:30-4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 16, 2005

PLD

  
HUYEN LE  
PRIMARY EXAMINER